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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,875	07/20/2005	Jonathan Rhodes	69155-2	1901

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EXAMINER	
MCCORMICK, MELENIE LEE	
ART UNIT	**PAPER NUMBER**
1655	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/542,875	RHODES, JONATHAN	
	Examiner	Art Unit	
	Melenie McCormick	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-13,19-30,32 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 5-7,10-13,19-30,32 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed on 07/25/06 is acknowledged.

Claims 1-3, 5-13, and 19-30 and 32-33 are presented for examination on the merits.

Claim Rejections - 35 USC § 102/103

Claims 1-3, 5-7, 10-13, 19-30 and 32-33 stand rejected under 35 U.S.C. 102 (b) or alternatively under 35 U.S.C. 103 (a) as being unpatentable over Fagbemi (Plant Foods for Human Nutrition) for the reasons set forth in the previous Office Action and restated below.

The cited reference discloses a composition (flour) obtained from plantains (*Musa paradisiaca*) which appears to be identical to the presently claimed fiber composition from fruit of the *Musa* spp. since it was prepared in the same essential manner as instantly disclosed/claimed (as previously stated) in that the flour is produced from plantains which were peeled, sliced, blanched at 100°C (boiling), dried, milled and further dried (see e.g. p. 262 para 2). Please note that boiling the fruit serves to remove starch. The flour disclosed by Fagbemi would intrinsically be in the form of a powder. Fagbemi further teaches that the flour can be incorporated into food and beverage products (see e.g. p. 264 para 2). Consequently, the claimed *Musa* fiber composition appears to be anticipated by the reference.

In the alternative, even if the claimed extract composition is not identical to the referenced extract composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to

be so slight that the referenced extract composition is likely to inherently possess the same characteristics of the claimed extract composition, particularly in view of the similar characteristics which they have been shown to share. Please note that the inevitable ingestion of the food product taught by Fagbemi would intrinsically treat Inflammatory Bowel Disease with respect to preventing Inflammatory Bowel Disease. As drafted, claims drawn to a method of treating Inflammatory Bowel Disease read on treating Inflammatory Bowel Disease in a subject so as to prevent/reduce the risk of the disease, as administering therapeutic compositions for Inflammatory Bowel Disease would intrinsically prevent the condition in any subject who does not have Inflammatory Bowel Disease. If necessary, the adjustment of particular conventional working conditions (e.g. adding a wash step using ethanol) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan. Thus, the claimed extract composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

As discussed in the previous Office Action, with respect to the art rejection above, please note that "the patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed.

Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

Further (as discussed in the previous Office Action), with respect to the art rejection above, it is noted that the reference does not teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. Please note that when applicant claims a composition in terms of function and the composition of the prior art appears to be the same, the Examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection (MPEP 2112).

With respect to the USC 102/103 rejection above, please note that the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicants' *Musa* fiber composition differs and, if so, to what extent, from that of the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

Applicant's arguments filed on 07/25/06 have been fully considered but are not deemed persuasive. Applicants argue that Fagbemi teaches a flour which contains a crude fiber, whereas applicant's claims encompass *substantially starch free soluble fiber*. As previously stated, the composition beneficially taught by Fagbemi was boiled (blanched at 100°C), therefore, an amount of starch has been removed, regardless of whether this was apparent to Fagbemi at the time. Moreover, the ripened plantains would intrinsically have a lower amount of starch, due to the conversion of starch to simple sugars which occurs during the ripening process (see e.g. p.267, second para). Hence, the composition beneficially taught by Fagbemi would be substantially starch free. Applicants further argue that the composition beneficially taught by Fagbemi does not contain soluble fiber. The composition beneficially taught by Fagbemi would, however, contain soluble fiber, as it is an intrinsic characteristic of plantains. As referenced by Tanya et al., boiled plantains contain soluble dietary fiber, and in fact boiled plantains contain a greater content of soluble dietary fiber than plantains processed by other methods (i.e. frying) (see e.g. p. 206 last paragraph). As a result, the boiled plantain composition beneficially taught by Fagbemi would intrinsically be substantially starch free, due to the method of processing, and would intrinsically contain soluble fiber (even if it is not assayed for and reported, as was the crude fiber content). Accordingly, the art rejections above are deemed proper and are, thus, maintained.

Claim Objections

Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melenie McCormick whose telephone number is (571) 272-8037. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHRISTOPHER R. TATE
PRIMARY EXAMINER